

REMARKS

Claims 1-21 are all of the claims presently pending in the application. The claims have not been amended by the present Response.

Applicant gratefully acknowledges the Examiner's indication that claims 9-13 and 19-21 are allowed.

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Nakamura (U.S. Patent No. 6,243,563). Claim 8 stands rejected under 35 U.S.C. § 102(b) as being anticipated by JP No. 09-46110 to Wataya Masafumi (hereinafter "JP '110"). Claims 2-7 and 14-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakamura in view of JP '110.

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention (e.g., as defined by exemplary claim 1) is directed to a portable telephone set including a detector for detecting a better receiving sensitivity one of radio signals received by an exclusive receiving antenna for only receiving radio signals and a transmitting and receiving antenna for transmitting and receiving radio signals, a switch for selecting the radio signal determined in the detector to be the better receiving sensitivity one, and a radio circuit for demodulating the radio signal from the switch (e.g., see Application at page 5, lines 16-25).

The claimed invention (e.g., as defined by exemplary claim 8) is directed to a portable telephone set including a radio circuit for demodulating a radio signal received by an antenna and transmitted via a cable, and a battery for supplying power to the radio circuit, wherein the battery and the radio circuit are interconnected by the cable, and wherein power from the battery is supplied via the cable to the radio circuit (e.g., see Application at page 8, lines 7-14).

The claimed invention, of exemplary claims 1 and 8, provides a portable telephone capable of efficient inter-housing transmission of radio signals (see Application at page 5, lines 12-15). Furthermore, the claimed invention provides a portable telephone set with reduced size and weight (see Application at page 5, lines 9-11).

II. THE REJECTIONS BASED ON PRIOR ART REFERENCES

A. Claim 1

The Examiner alleges that Nakamura teaches the claimed invention of claim 1. Applicant submits, however, that there are elements of the claimed invention, which are neither taught nor suggested by Nakamura.

That is, Nakamura does not teach or suggest “*a radio circuit for demodulating the radio signal from the switch*” as recited by exemplary claim 1.

The Examiner attempts to rely on Figure 2 and column 3, lines 10-39 of Nakamura to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in this figure nor this passage (nor anywhere else for that matter) does Nakamura teach or suggest a radio circuit for demodulating the radio signal from the switch. Indeed, Nakamura does not provide a radio circuit for demodulating the radio signal having the better receiving sensitivity sent from the switch, as recited in the claimed invention of exemplary claim 1.

In contrast, Nakamura teaches that the demodulator (6) receives a signal from the reception dedicated antenna (1), through the reception dedicated switch (3), and a signal from the common antenna (2), through the common switch. The demodulator (6) then sends two demodulated RSSI signals to a switch controller (11) (see Nakamura at column 5, lines 22 through 64). The switch controller (11) compares the levels of the two demodulated RSSI signals and selects a RSSI signal having a higher level (see column 6, lines 11-20).

However, Nakamura does not teach or suggest that the demodulator (6) demodulates a radio signal from the switch controller. In the claimed invention of exemplary claim 1, a detector detects a radio signal having a better receiving sensitivity and a switch for selecting the better receiving sensitivity signal. The switch then sends the better receiving sensitivity signal to the radio circuit to demodulate the signal. Nakamura, however, teaches demodulating the signals prior to detecting which signal has a higher level. Therefore, the radio circuit of Nakamura does not demodulate a radio signal having a better receiving sensitivity received from the switch.

Therefore, Applicants respectfully submit that there are elements of the claimed invention that are neither taught nor suggested by Nakamura. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

B. Claim 8

The Examiner alleges that JP '110 teaches the claimed invention of claim 8. Applicant submits, however, that there are elements of the claimed invention, which are neither taught nor suggested by JP '110.

That is, JP '110 does not teach or suggest "*wherein power from the battery is supplied via the cable to the radio circuit*" as recited by claim 8.

The Examiner attempts to rely on Figure 1 of JP '110 to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in Figure 1 (nor anywhere else for that matter) does JP '110 teach or suggest that power from the battery is supplied via the cable to the radio circuit. Indeed, JP '110 merely teaches transmitting power from a power supply section (9) through a coaxial cable (32) to a high frequency amplifier (7) (see JP '110 at Abstract).

That is, as best understood, the "radio circuit for demodulating the radio signal" in JP '110 is located in the main body 3 ("...and the amplified signal is fed to a receiver of the telephone set main body 3"). Thus, the configuration shown in JP '110 fails to satisfy the plain meaning of the claim language, since the battery (B) and the power supply circuit (23) are also located in the main body 3.

If the Examiner wishes, however, to continue to rely on JP '110, it is requested that the Examiner specifically point out which features of JP '110 he is relying on as teaching each of the limitations of the claimed invention.

Therefore, Applicant submits that there are elements of the claimed invention that are not taught or suggested by JP '110. Therefore, the Examiner is respectfully requested to withdraw this rejection.

C. Claims 2-7 and 14-18

The Examiner alleges that JP '110 would have been combined with Nakamura to form the claimed invention of claims 2-7 and 14-18. Applicant submits, however, that these references would not have been combined and that, even if combined, the combination would not teach or suggest each and every element of the claimed invention.

That is, section 2142 of the MPEP states:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” (Emphasis added).

Applicants respectfully submit that the Examiner has not even provided an alleged suggestion of motivation to combine the references. Indeed, the Examiner merely states that it would have been obvious to combine the teachings of JP ‘110 with the device of Nakamura “such that the transmitter with which attenuation by transmission on the body of a transmitter of an input signal can be compensated via a cable” (see Office Action dated page 5). The Examiner has merely indicated the results of the teachings of JP ‘110, but has not provided any motivation or suggestion for combining those teachings with Nakamura.

Second, it is pointed out that MPEP §2143.01 clearly states a second guideline: “*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination*” (emphasis in MPEP itself).

Along these lines, Judge Rader wrote in the recent Federal Circuit Court of Appeals holding in *Ruiz v. A.B. Chance Co.*, Federal Cir., No. 03-1333, January 29, 2004:

*“In making the assessment of differences, section 103 specifically requires consideration of the claimed invention “as a whole.” Inventions typically are new combinations of existing principles or features. *Envtl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that “virtually all [inventions] are combinations of old elements.”). The “as a whole” instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention.”*

Although the holding in that case left undisturbed, under the “clear error” standard of review, the conclusion of the District Court that the prior art references were properly combinable, it specifically explained that it declined to reverse this conclusion because “... the two references address precisely the same problem ... ” (emphasis by Applicants)

This aspect of the *Ruiz* holding, in which precisely the same problem is being

addressed by both references, is not present in the JP '110 and Nakamura references used in the prior art evaluation of the present Application.

Specifically, the Nakamura reference is directed to preventing breakage of structural elements due to a high power transmission radio signal in a wireless device whereas the JP '110 reference is merely directed to compensating the attenuation due to transmission of a reception signal by connecting a high frequency amplifier to a reception exclusive antenna via a cable.

Therefore, the Examiner has clearly failed to establish a *prima facie* case of obviousness.

Moreover, neither JP '110, nor Nakamura, nor any combination thereof, teaches or suggests "*a radio circuit for demodulating the radio signal from the switch*" as recited in claim 1, and similarly recited in claims 2-5.

The Examiner attempts to rely on Figure 2 and column 3, lines 10-39 of Nakamura to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in this figure nor this passage (nor anywhere else for that matter) does Nakamura teach or suggest a radio circuit for demodulating the radio signal from the switch. Indeed, Nakamura does not provide a radio circuit for demodulating the radio signal having the better receiving sensitivity sent from the switch, as recited in the claimed invention of exemplary claim 1.

In contrast, Nakamura teaches that the demodulator (6) receives a signal from the reception dedicated antenna (1), through the reception dedicated switch (3), and a signal from the common antenna (2), through the common switch. The demodulator (6) then sends two demodulated RSSI signals to a switch controller (11) (see Nakamura at column 5, lines 22 through 64). The switch controller (11) compares the levels of the two demodulated RSSI signals and selects a RSSI signal having a higher level (see column 6, lines 11-20).

However, Nakamura does not teach or suggest that the demodulator (6) demodulates a radio signal from the switch controller. In the claimed invention of exemplary claim 1, a detector detects a radio signal having a better receiving sensitivity and a switch for selecting the better receiving sensitivity signal. The switch then sends the better receiving sensitivity signal to the radio circuit to demodulate the signal. Nakamura, however, teaches demodulating the signals prior to detecting which signal has a higher level. Therefore, the radio circuit of Nakamura does not demodulate a radio signal having a better receiving

sensitivity received from the switch.

Furthermore, the Examiner does not even allege that JP '110 teaches or suggest a radio circuit for demodulating the radio signal from the switch. Thus, JP '110 fails to make up the deficiencies of Nakamura.

Therefore, Applicant respectfully submits that these references would not have been combined as alleged by the Examiner, and that even if combined, would not teach or suggest each and every feature of the claimed invention.

III. FORMAL MATTERS AND CONCLUSION


In view of the foregoing, Applicant submits that claims 1-21, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

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Respectfully Submitted,



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